

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office action dated August 9, 2006 are respectfully requested. Claims 1-27 are currently pending in this application. Claim 28 has been cancelled without prejudice. Claims 29-73 have been withdrawn. The applicant reserves the right to reintroduce the cancelled claim at a later date if desired.

Claim Objections

The Examiner objects to claims 22 and 26 because of informalities.

102 Rejections

The Examiner rejected claims 1, 2, 4, 5, 10, 13, 17, and 20-26 under 35 U.S.C. 102(e) as being anticipated by Berarducci et al. [US 20050225799 A1].

103 Rejections

The Examiner rejected claims 3 and 12 under 35 U.S.C. 103(a) as being unpatentable over Berarducci et al. in view of Mauro et al [US 20030200099 A1].

The Examiner further rejected claims 6-8 under 35 U.S.C. 103(a) as being unpatentable over Berarducci et al. in view of Ramachandran et al. [US 20010044747 A1].

The Examiner further rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Berarducci et al. in view of House et al. [US 20030229536 A1].

The Examiner further rejected claims 11, 14, 15, 27, and 28 under 35 U.S.C. 103(a) as being unpatentable over Berarducci et al. in view of Paul [US 20040171371 A1].

The Examiner further rejected claim 16 under 35 U.S.C. 103(a) as being unpatentable over Berarducci et al. in view of Chauvin et al.[US 20030038882 A1].

The Examiner further rejected claims 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Berarducci et al. in view of von Rosen et al. [US 20030069809 A1].

Claim Objections

The Examiner objects to claim 22 because of the informality that in elements (b) and (c), the phrase “within each system component contain” does not make sense grammatically. The Examiner suggests editing the phrase to read “wherein each system component contains”. The applicant has amended claim 22 in the manner suggested by the Examiner, and respectfully submits that claim 22, as amended, is acceptable.

The Examiner also objects to claim 26 because of the informality that the phrase “one system component is user email account” should be changed to read “one system component is a user email account”. The applicant has amended claim 26 in the manner suggested by the Examiner, and respectfully submits that claim 26, as amended, is acceptable.

The Cited Prior Art

Berarducci et al.

Berarducci et al. disclose a method of transferring images captured by a digital camera to a remote memory location over a channel such as the Internet. The remote memory location may be a fulfillment center. The method of Berarducci et al. includes the placing of orders by users with fulfillment centers for the processing and fulfillment of images taken with digital cameras.

To place an order, a user logs onto an Internet site and enters name, password, and delivery and billing information. A service user account is then established for the user. A menu of customized digitally printed products and prices is provided to the user, who then selects what type of product to purchase. The user is then provided with a menu of customizable features, and proceeds to select preferred features. Next, the user selects images to be uploaded, and selects a time at which the images are to be uploaded. The order information provided by the user is stored in the user's account. The user's images are uploaded at the time selected by the user. The production controller then creates the photo products based on the user's order. A shipping label is produced and attached to a shipping container. The user's customer account is billed

for the order, and the product is shipped to the user, typically by US mail or a shipping service such as UPS or Federal Express.

The user provides several types of information in the course of placing an order. In addition to user name, password, delivery and billing information, the user provides further service account information listing desired photo product options. Such options include the page size, background style, and type of albums, the frame size, frame style, and matte style of framed prints, and the print size and print finish of service prints. However, the service account information does not include such features as a choice of digital photography enhancement, a choice of automated rendering, a choice of digital photography layout, or a preferred means of notification. Berarducci et al. thus teach away from the user personalization aspect of the user provisioner in the system of the applicant, which includes those features.

Additionally, in the system of Berarducci et al., the user must manually input the service account options when placing an order on at least one occasion. The options are not included automatically when the order is placed. Thus, Berarducci et al. also teach away from automatic performance of sending an order including the user provisioner of the system of the applicant, as the service account options do not directly correspond to the features of the user provisioner and the inclusion of the options is not automatic.

House et al.

House et al. disclose a system, method, computer program product, and data signal for providing a media-related service for planning and executing a marketing communications campaign using a computer-implemented system. House et al. teach that the marketing medium may be direct mail, but do not disclose or suggest direct mail, self mailer, or drop-off mailer as a means of identifying a user.

Chauvin et al.

Chauvin et al. teach a system, method, and software product for ordering of digital photo services among a plurality of order terminals. Chauvin et al. state that many different types of order terminals are possible, and state that an order terminal may be a portable wireless imaging device such as a cell phone, a personal digital

assistant (PDA), or a digital camera. Chauvin et al. thus give personal digital assistants and digital cameras as examples of wireless imaging devices. But in Chauvin et al, the wireless imaging devices are used to place orders; digital images are not acquired from the wireless imaging devices in Chauvin et al., as they are in the system of the applicant. Thus, the environments of Chauvin et al. and the applicant are dissimilar in an important respect. Further, while Chauvin et al. mention portable digital assistants and digital cameras, Chauvin et al do not mention or suggest a portable digital assistant *with a digital camera extension*. Chauvin et al. thus teach away from using a personal digital assistant with a digital camera extension to acquire a digital image, and teach away from acquiring a digital image from a personal digital assistant with a digital camera extension.

The Prior Art Distinguished

Claim 1

The Examiner rejects claim 1 under 35 U.S.C. 102(e) as being anticipated by Berarducci et al. The Examiner claims that each of body elements (a) through (k) is anticipated in one or more paragraphs of Berarducci et al. The applicant does not at this time contest the Examiner's claims with respect to body elements (a), (b), (e), (j) and (k). The applicant does contest the Examiner's claims with respect to body elements (c), (d), (f), (g), (h) and (i).

The Examiner claims that element (c) is anticipated by at least paragraph 40 of Berarducci et al. Paragraph 40 mentions the establishment of user service accounts that include such information as customer name, password, delivery and billing information, augmented by additional information listing the photo product options selected by the customer. Berarducci et al. do not define the additional information listing the photo product options, but paragraph 40 refers to Figs. 5A and 5B for examples of such information. Fig. 5A includes examples of three product types: album, framed print, and service print. The album product type includes the following types of information: page size, album type, background style, style, font and color of page numbers, and ship to designee. The framed print product type includes the following types of information: frame size, frame style, matte style, image numbers, and ship to

designee. The service print product type includes the following types of information: print size, print finish, date stamp, image numbers, and ship to designee.

The Examiner apparently identifies the user provisioner mentioned in claim 1 with the service account and service account options mentioned in Berarducci et al.

Element (c) of claim 1 has been amended to make explicit the contents of the user provisioner. It should be clear from element (c) of claim 1, as amended, that the Examiner's identification of the user provisioner with the service account and options is erroneous. The user provisioner and the service account and options are not comparable; indeed, nothing in Berarducci et al. corresponds to the user provisioner. While the profile aspect of the user provisioner and the service account contain some of the same information, the personalization and customization aspects of the user provisioner differ in important respects from the service account information and options of Berarducci et al. For example, the personalization aspect includes all of the following: a choice of digital photography enhancement; a choice of automated rendering, such as ignoring over-developed or under-developed photographs or automatic image rotation; a choice of digital photography layout, and a preferred means of notification, such as mobile, PDA, email, or web service. None of this information is contained in the service account information and options of Berarducci et al. More generally, the information contained in the service account information and options of Berarducci et al. is low-level, particular, and concerned with the properties of the physical fulfillment, whereas the information contained in the personalization aspect of the user provisioner is relatively general, high-level, and concerned with the actual rendering of digital images.

If, as argued here, the Examiner's identification of the various aspects of the user provisioner with the service account information and options of Berarducci et al. is erroneous, then the Examiner's claim that element (c) of claim 1 is anticipated by Berarducci et al. is without support.

The Examiner claims that element (d) is anticipated by at least paragraph 33 of Berarducci et al. Paragraph 33 concerns the events that transpire when a user purchases a photo product. The Examiner takes such a purchase to involve the user placing an order, where the order includes service account information of the sort mentioned in paragraph 40 and Figs. 5A and 5B. The Examiner apparently takes the

placing of the order including service account information to correspond to the user sending a processing and fulfillment order along with the user provisioner. The applicant has argued above that the service account information of Berarducci et al. should not be identified with the user provisioner. Accordingly, the applicant argues that the placing of an order including service account information does not correspond to the user sending a processing and fulfillment order along with the user provisioner.

The applicant also points out that element (d) states that the performance of the single event instantiation process that includes sending an order along with the user provisioner is automatic, and does not involve any special action by the user apart from making an order request. Thus, the user provisioner is included automatically when the user places an order. This contrasts with the system of Berarducci et al., who do not state that the service account information is included automatically when the user places an order. As is clear from Figs. 2A and 2B and the text of the detailed description of Berarducci et al., the user must input the service account information manually at least once during the process of placing an initial order. Once the service account information has been inputted once, the service account information is retained in a database for use with subsequent orders placed by the user. When the user places a subsequent order, the network server accesses the previously inputted service account information and displays that information for the user, who may select to reuse the previous service account information or to use new service account information. Thus, the incorporation of the service account information into the subsequent order is not automatic in the system of Berarducci et al.

Since the user provisioner does not correspond to the service account information and the process of placing an order in Berarducci et al. does not automatically include the service account information, the applicant respectfully submits that the Examiner's claim that element (d) is anticipated by Berarducci et al. is without support.

The Examiner claims that element (f) is anticipated by at least paragraph 33 of Berarducci et al. Paragraph 33 concerns the events that transpire when a user purchases a photo product. The Examiner takes such a purchase to involve the user placing an order, where the order includes service account information of the sort mentioned in paragraph 40 and Figs. 5A and 5B. Element (f) mentions retrieving the

provisioner, which the Examiner apparently identifies with the service account information. The applicant has argued above that the provisioner and the service account information should not be identified; thus, the Examiner's claim is without support.

The Examiner claims that element (g) is anticipated by Berarducci et al., but does not provide a reference. However, element (g) mentions the user provisioner. The applicant has argued above that nothing in Berarducci et al. corresponds to the user provisioner. Therefore, the applicant respectfully submits that the Examiner's claim is without support.

The Examiner claims that element (h) is anticipated by at least paragraph 39 of Berarducci et al. Paragraph 39 mentions delivery information, which the Examiner apparently takes to correspond to retrieving a fulfillment delivery method using said user provisioner. The applicant has argued above that nothing in Berarducci et al. corresponds to the user provisioner. Therefore, the applicant respectfully submits that the Examiner's claim is without support.

The Examiner claims that element (i) is anticipated by at least paragraph 41 of Berarducci et al. Paragraph 41 partly concerns a fulfillment center providing a user with preferred times for image uploads, which the Examiner apparently takes to count as providing for user personalization and customization of the order processing and fulfillment workflow using the user provisioner. However, it is clear from claim 1, element (c), as amended, that providing preferred times for image uploads does not fall under the user personalization and customization aspects of the user provisioner. Thus, the applicant respectfully submits that the Examiner's claim that element (i) is anticipated by Berarducci et al. is without support.

The applicant has argued that elements (c), as amended, (d), (f), (g), (h), and (i) of claim 1 are not anticipated by Berarducci et al. Accordingly, the applicant submits that claim 1, as amended, and also claims 2-27, which depend from claim 1, are allowable over Berarducci et al.

Claim 22

The Examiner rejects claim 22 under 35 U.S.C. 102(e) as being anticipated by Berarducci et al. Claim 22, as amended, reads in part “ ... wherein each system component contains the necessary computing resources to access and augment the user provisioner” The Examiner claims that this passage is anticipated by at least paragraph 40 of Berarducci et al, which states that the initial service account information of name, password, and delivery and billing information is augmented by additional information listing the photo product options selected by the customer. Again, the Examiner apparently identifies the service account information of Berarducci et al. with the user provisioner of the system of the applicant. The applicant has argued above that such an identification is erroneous; the service account information does not adequately correspond to the aspects of the user provisioner. Accordingly, the augmentation of service account information mentioned in paragraph 40 of Berarducci et al. does not adequately correspond to the augmentation of the user provisioner mentioned in claim 22.

The applicant respectfully submits that the Examiner’s claim is without support. The applicant further argues that the cited part of claim 22 is not anticipated by Berarducci et al, and is therefore allowable over Berarducci et al.

Claim 9

The Examiner rejects claim 9 under 35 U.S.C. 103(a) as being unpatentable over Berarducci in view of House et al. The Examiner claims that House et al. disclose that the single-event instantiation of user identification is a self mailer/drop-off mailer model, in a similar environment, and cites House et al., at least paragraph 73 in support of this claim. House et al., paragraph 73, mentions direct mail as a medium of marketing, but does not mention or suggest a self mailer or drop-off mailer as a means of identification of a user. Further, the environment of House et al. is computer-implemented marketing, whereas the environment of the applicant is placing an order for digital image fulfillment. The applicant respectfully submits that the two environments are dissimilar. The applicant argues that the Examiner’s claim is without support. Thus, the applicant claims that claim 9 is not obvious over Berarducci et al. in view of House et al., and is therefore patentable over Berarducci et al. in view of House et al.

Claim 16

The Examiner rejects claim 16 under 35 U.S.C. 103(a) as being unpatentable over Berarducci in view of Chauvin et al. The Examiner claims that Chauvin et al. disclose that the digital imaging device is a portable digital assistant computing device with digital camera extension, and cites Chauvin et al., at least paragraph 51, in a similar environment, in support of this claim. Chauvin et al. teach a system, method, and software product for ordering of digital photo services among a plurality of order terminals. In paragraph 51, Chauvin et al. state that many different types of order terminals are possible, and state that an order terminal may be a portable wireless imaging device such as a cell phone, a personal digital assistant (PDA), or a digital camera. Chauvin et al. thus give personal digital assistants and digital cameras as examples of wireless imaging devices. But in Chauvin et al, the wireless imaging devices are used to place orders; digital images are not acquired from the wireless imaging devices in Chauvin et al., as they are in claim 16 (see element (b) of claim 1, from which claim 16 depends). Thus, the environments of Chauvin et al. and the applicant are dissimilar in at least one important respect. Further, while Chauvin et al. mention portable digital assistants and digital cameras, Chauvin et al do not mention or suggest a portable digital assistant *with a digital camera extension*, as mentioned in claim 16. The applicant therefore respectfully submits that the Examiner's claim is without support. The applicant argues that claim 16 is not obvious in light of Berarducci et al. and Chauvin et al., and is therefore patentable over Berarducci et al. in view of Chauvin et al.

Conclusion

The applicant respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance. Should the Examiner find that a telephone or in-person conference would expedite the prosecution of this Application further, he is invited to contact the applicant's counsel at the contact listed below for such a conference.

No further fees are believed due with this communication. However, the Commissioner is hereby authorized and requested to charge any deficiency in fees to Deposit Account No. 50-2207.

Respectfully submitted,
Perkins Coie LLP

A handwritten signature in black ink, appearing to read 'Brian R. Coleman', is written over a horizontal line.

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